

REMARKS

Claims Readable on Elected Embodiment

Claims 20-25 and 27-31 are readable on the elected embodiment of Figs. 11 and 12. Claim 26 depends from claim 20 and is readable on the embodiment of Figs. 7-9. The only difference between the embodiment of Figs. 7-9 and the embodiment of Figs. 11 and 12 is that the cavities and inserts are of different shape in the "big toe" area. Claim 26 should be allowed if claim 20 is allowed.

Claim Support

The new claims are fully supported by the application, as originally filed, as demonstrated below. In general, it will be noted that the elected embodiment (Figs. 11-12) is stated in the application as being similar to the previous embodiment described in Figs. 8 and 9. Thus much of the support for the new claims is taken from the description first presented in regard to Figs. 8 and 9. (Fig. 7 is a section taken from Fig. 8, so it is also relevant.)

Claim 20 -The language used in claim 20 is virtually identical to language used in prior claims, the only exception being that the new claim specifies a "unitary" outsole and "no midsole". This construction is described in the drawings and on page 13 of the application where the footwear is stated to comprise a conventional insole 194 and a sole 196 comprising a "unitary outsole 200" formed with a cavity 210 for receiving a metal shank 212 and foam insert 214. Fig. 8 illustrates this construction and clearly show the absence of a midsole, i.e., an intervening midsole layer sandwiched between the upper surface of the outsole 200 (outside of the cavity 210) and the overlying insole 194. In the embodiment shown, the insole 194 rests on the ribs 206 of the outsole, not on an intervening midsole. (See description on page 13, lines 15-2.)

Claim 21 - Figs. 7-9; page 13, lines 25-30.

Claim 22 - Figs. 7-9.

Claim 23 - Figs. 7-9; page 13, lines 17-30.
Claim 24 - Figs. 11-12.
Claim 25 - Figs. 11-12.
Claim 26 - Figs. 7-9.
Claim 27 - Figs. 11-12; page 14, lines 26 et seq.
Claim 28 - Figs. 7-9; page 13, lines 25-31.
Claim 29 - Page 8, lines 11-27.
Claim 30 - Page 8, lines 11-27.
Claim 31 - See discussion regarding claim 20; Figs. 7-9; page 8, lines 11-27; page 13, lines 10-34; page 14, lines 1-17.

Claims 20-31 Patentably Distinguish Over the Cited Art

New claims 20-31 patentably distinguish over the prior art, as discussed below.

Steinbrecher (1,387,952) - This patent shows a shoe having an outer sole 14, a layer (not numbered) immediately above the outer sole, a plate or shank 10 of sheet steel or other suitable material overlying the layer to provide support for the arch, an inner sole 15 over the plate, and a lining 16 overlying the inner sole. The reference fails to show the features specified in claims 20 and 31, including a cavity in a unitary outsole, or applicant's claimed insert in the cavity. It will be noted in this regard that applicant's claimed insert has a resistance to compression less than the compression of the outsole, whereas, the plate 10, as pointed out by the Examiner, has a resistance to compression greater than the surrounding area. Further, the un-numbered layer above the outer sole 14 is either a part of the outer sole, in which case the shoe does not have a "unitary outsole", as claimed by applicant, or it is a midsole not present in applicant's footwear. Steinbrecher also fails to show any of the features specified in claims 21-29.

Lelyveld (1,557,312) - This patent shows a shoe having an outer sole 13, an inner sole 12 and a sheet metal plate between the two. The reference fails to show the features specified in claims 20 and 31, including a cavity in a unitary outsole, or applicant's claimed insert in the cavity. It will be noted in

this regard that applicant's claimed insert has a resistance to compression less than the compression of the outsole, whereas the sheet metal plate, as pointed out by the Examiner, has a resistance to compression greater than the surrounding area. Lelyveld also fails to show any of the features specified in claims 21-29.

Fink (4,680,877) - This patent shows a multi-layered insole structure for use in a sports shoe. It fails to show or suggest applicant's claimed unitary outsole, or a cavity in the outsole, or applicant's claimed insert in the cavity. Fink also fails to teach any of the features specified in claims 21-29.

Wildman et al (4,642,912) - This patent shows a shoe insole having three layers. While the insole is likely intended for use in footwear having an outsole, there is no disclosure or suggestion that the insole is to be used in combination with applicant's claimed unitary outsole formed with a cavity, or with applicant's claimed insert in the cavity. Fink also fails to teach any of the features specified in claims 21-29.

Moronaga et al. (4,633,598) - This patent shows an insole for athletic shoes having upper and lower layers and a shock-absorbing foam layer between the upper and lower layers. It fails to show or suggest applicant's claimed footwear having a unitary outsole with a cavity therein, or applicant's claimed insert in the cavity. Moronaga et al. also fail to teach any of the features specified in claims 21-29.

Chapnick (4,586,273) - This patent shows an insert for a shoe or sneaker to reduce impact to the foot. The insert is comprised of a base layer 12 of resilient material, a support layer 13, a foam layer 11 disposed over the base layer, and a fabric layer 14 disposed over the foam layer. Chapnick fails to show or suggest applicant's claimed footwear having a unitary outsole with a cavity therein, or applicant's claimed insert in the cavity. Chapnick also fails to teach any of the features specified in claims 21-29.

Cavanagh (4,506,462) - This patent discloses a running shoe having a relatively thin outer sole layer 5 of hard, wear-

resistant material, a midsole layer 3 of resilient cushioning material, and a heel sole layer 4 between the outer sole and midsole layers along approximately the rear half of the sole. Cavanagh fails to show footwear having no midsole, or a unitary outsole with applicant's claimed cavity therein, or applicant's claimed insert in the cavity. Cavanagh also fails to teach any of the features specified in claims 21-29.

Regarding the prior art patents to Fink, Wildman et al, Moronaga et al., Chapnick and Cavanagh, in the Office action dated June 18, 2003, the examiner noted that each of these patents discloses layers of different hardness extending under the entire foot, and that such layers thus necessarily extend under the areas of the foot as claimed. It will be noted that claims 20 and 31 specify that applicant's claimed insert overlies certain areas of the unitary outsole but not other areas of the outsole. As a result, areas of the foot overlying the insert are provided with more shock absorption, while areas of the foot overlying the outsole but not the insert are provided with firmer support. It is submitted that this difference further distinguishes over the prior art of record.

Double Patenting Rejection

The claims of the present application are directed to a different invention than applicant's U.S. Patent Nos. 5,787,610 and 5,964,046. Specifically, new claims 20-31 are directed to the embodiment shown in Figs. 10 and 11 (and also, except for claim 27, to the embodiment shown in Figs. 7-9), where the outsole is of unitary construction and has a cavity in it for receiving a insert which overlies certain areas of the outsole to provide shock attenuation for corresponding areas of the foot, but not other areas of the outsole so that the foot has firmer support in these areas. This specific construction is neither shown nor suggested in the '610 and '046 patents, and thus no terminal disclaimer should be required.

Conclusion

In view of the foregoing, it is submitted that applicant has fully addressed the rejections raised in the Office action of June 18, 2003, and distinctly and specifically pointed out how claims 20-31 patentably define over the cited art. Accordingly, favorable reconsideration and allowance of claims 20-31 is requested.

It is believed that no fees are due in connection with this Letter. If, however, the Commissioner determines a fee is due, he is hereby authorized to charge said government fees to Deposit Account No. 19-1345.

Respectfully submitted,



Michael E. Godar, Reg. No. 28,416
SENNIGER, POWERS, LEAVITT & ROEDEL
One Metropolitan Square, 16th Floor
St. Louis, Missouri 63102
(314) 231-5400

MEG/bcw

Express Mail Label No. EL 910603209 US